

anti-static properties. However, the rejection is respectfully traversed for the reasons outlined below.

As an initial matter, it is important to note that the House reference is directed to a work-surface covering pad with a hard outer cover 108. The outer cover 108 is disclosed to be made of, for example, polyvinyl chloride, polycarbonate, polystyrene, polyester, acetate films or scratch resistant vinyl (column 4, lines 51-65). The outer cover 108 is textured (column 4, lines 55-58), and may be transparent and have anti-static properties (column 5, lines 17-19). The outer cover 108 does not appear to be disclosed to be made of paper.

As can be seen in the embodiments of Figs. 5, 7 and 9, the work-surface covering pad of the House reference can receive sheet materials 140 under the outer cover 108. The outer cover 108 protects the sheet materials 140 stored thereunder, and a plurality of sheet materials 140 can apparently be stored under the outer cover 108 (see column 6, lines 41-43, and column 7, line 54).

As correctly noted in the Office action, the House reference discloses that the *top* outer cover 108 may have anti-static properties. The Office then goes on to conclude, however, that this disclosure would teach one of ordinary skill in the art to make *each sheet* in a mousepad have anti-static properties. However it is submitted that this is most decidedly *not* taught by the House reference. More particularly, the House reference explicitly discloses that a plurality of sheet materials 140 are positioned below the outer cover 108. The House reference does not disclose that those sheets 140 have any anti-static property. Instead, it is only the hard, protective outer cover 108 that is disclosed to have any anti-static properties. Thus, the Office action essentially takes the position that the House reference "teaches" a feature that is contradicted, or at least not supported, by the remaining disclosure of the House reference since the sheets 140 are not disclosed to have any anti-static property. The Office action does not cite to any teaching or suggestion why one of ordinary skill in the art would use the cover 108 in any manner different than which it is to be disclosed to be used (as a hard, rigid protective cover).

Instead, and more accurately, the House reference discloses the use of a transparent, hard, textured outer cover 108 which may have anti-static properties. Thus, if the House reference were to somehow be combined with the GB reference, the resultant structure would be that the mousepad of the GB reference would have the outer cover 108 of the House reference located on

top thereof. The papers 1 of the GB reference are analogous to the sheets 140 of the House reference. The "Mouse Pad Calendar" web page print-out cited in the Office action supports this conclusion, since it instructs a user to insert six calendar sheets "under a special textured clear surface." Thus, it is submitted that one of ordinary skill in the art, when combining the GB and House references, would use the cover 108 in the same manner it is taught to be used in the House and "Mouse Pad Calendar" references.

In addition, it is submitted that if the anti-static properties of the rigid cover 108 were to be used on each individual sheet, this would entail placing a clear, rigid coating on each individual sheet. However, this would render each sheet rigid and stiff, and render the mousepad unwieldy and inoperable. It is possible that the Office action may be taking the position that the House reference discloses some sort of an anti-static coating or treatment on an upper surface of the cover 108 (which could be used on the sheets). However, such an interpretation is not supported, and the House reference instead discloses that the cover 108 has an antistatic "property" which implies it is an inherent "material property." Finally, even if it could be shown that House reference does disclose an anti-static coating or treatment on top of the rigid cover 108, there is no disclosure that such an the anti-static coating or treatment utilized would be effective or compatible in use or application with the bleed-proof paper of the GB reference.

Finally, it is submitted that the Office action does not provide a proper motivation for the proposed modification. More particularly, the Office action takes the position that it would have been obvious to make each sheet of the GB mousepad have anti-static properties "in order to avoid collecting dirt on the mouse pad." However, this motivation is identical to that recited in this application. More particularly, at page 3, lines 16-21 of this application, it is noted:

When the sheets 12 have anti-static properties or a low static electricity charge and a mouse is located and rolled or moved across the upper surface of the uppermost sheet 12", the anti-static or low-static nature of the sheet 12" reduces dust accumulation and reduces interference with the electrical components of the mouse to help ensure proper functioning of the mouse. The reduced dust accumulation on the sheets 12 also reduces dust accumulation in the mouse.

MPEP §2145 notes that "any judgment on obviousness is in a sense a reconstruction based on hindsight reasoning, but so long as it . . . *does not include knowledge gleaned only from applicant's disclosure*, such a reconstruction is proper."

In this case, the Office action uses an identical benefit cited in the application to reconstruct applicant's invention. None of the cited references recognize the need for an anti-static coating on each individual sheet which can at some time form the top-most sheet of the mousepad. No independent motivation for combining the cited reference is provided in the Office action, and the Office action thus appears to use this application as a template arrive at the claimed invention. This lack of sufficient "motivation to combine" is further evidence that one of ordinary skill in the art would not combine the references in the manner suggested in the Office action, and that the Office action has improperly combined the GB, Mouse Pad Calendar and House references. Accordingly, it is submitted that claims 1, 2, 4-14, 16, 28, 29, 39, 42 and 43 are patentable over the cited references.

At paragraph 5 of the Office action, claims 44-46, 48 and 49 are rejected as being unpatentable over the GB reference, in view of the "Mouse Pad Calendar" web page print-out, and in light of U. S. Statutory Invention Registration H377 to Greig. The Office action appears to acknowledge that the GB and Mouse Pad Calendar reference do not disclose the following portion of, for example, independent claim 44:

each sheet being joined to any adjacent sheets at least partially along at least two separate edges of that sheet such that each sheet can be removed from said stack of sheets in a tear-off manner and wherein each sheet is not directly joined to any adjacent sheet at an intermediate location along each edge of each sheet such that a user can slide a finger between the adjacent ones of said sheets at said intermediate location of each edge.

Claim 45 depends from claim 44 and specifies that each sheet is joined to each adjacent sheet only at each corner thereof.

The Office action cites to the Greig reference as teaching that "applying adhesive only to the corners is a functional equivalent known in the art (compare Figs. 3 and 4)." However, it is submitted that the rejection is not properly supported on the basis that the Greig reference simply does not disclose the claimed subject matter.

More particularly, Figs. 3 and 4 of Greig (referred to in the Office action) each disclose a sheet having an adhesive strip 20 extending entirely along an upper edge 14 of the sheets. In contrast, claim 44 specifies that each sheet is not directly joined to any adjacent sheet at an intermediate location *along each edge* of each sheet. In contrast, in both Fig. 3 and Fig. 4 of the

Serial No.: 10/611,391  
Attorney Docket No.: 100041-41143  
Response

Greig reference disclose an adhesive strip 20 extending entirely along the edge of the sheet and thereby the claimed "intermediate location" is simply not shown.

Claim 45 depends from claim 44 and specifies that each sheet is joined to an adjacent sheet *only at each corner thereof*. In contrast, in both Figs. 3 and 4 of Greig, the adhesive strip 20 extends completely along edge 14, and thereby discloses joining each sheet at locations other than only at the corners thereof.

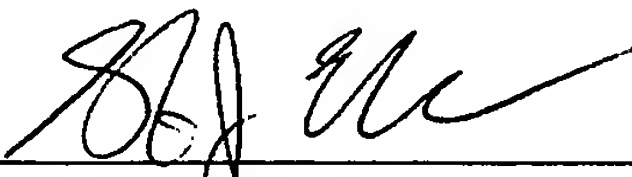
In addition, it should be noted that the Greig reference is directed to a different problem. The Greig reference discloses providing additional adhesive strips (i.e., in addition to the typical adhesive strip 14 extending along the top edge of the POST-IT® notes or the like) to prevent unintended removal of the sheets (see column 1, lines 25-27 and column 2, lines 14-23). The Greig reference is not focused upon providing an intermediate location along each edge of each sheet such that a user can slide a finger between adjacent ones of the sheets at an intermediate location of each edge. Thus, it is submitted that the subject matter of independent claims 44 and 48, as well as claims 3, 38, 40, 41, 45, 46 and 49, are not shown.

Finally is submitted that Applicant's previously-submitted evidence of commercial success retains merit and is probative of the non-obviousness of the invention.

Therefore it is submitted that the application is in a condition for allowance, and a formal notice thereof is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,

  
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